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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/344,492	06/25/1999	JOHN S. HENDRICKS	026880.00029	9126

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ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2421

NOTIFICATION DATE	DELIVERY MODE
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07/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/344,492	Applicant(s) HENDRICKS ET AL.	
	Examiner Jason P. Salce	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-17,25-27,30-34,36-41 and 50 is/are pending in the application.
 4a) Of the above claim(s) 18-22 and 42-46 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-17 and 36-41 is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10,25-27,30-34 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/23/2009 and 1/9/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/2009 has been entered.

Response to Arguments

Applicant's arguments filed 4/23/2009 have been fully considered but they are not persuasive.

Applicant has amended independent claims 1, 10, 25, 34 and 50 have been amended to recite, "**wherein the restricted version maintains the original format of the electronic book**". Applicant further argues that the Examiner's rejection fails to teach this limitation. The Examiner respectfully disagrees.

Handelman discloses receiving multiple versions of an electronic book are received and that parent control information is used to determine which version to display, wherein the parental control information controls "**which portions or which version of all or a portion of the document may be displayed**" (see Column 17, Lines 27-36 and Column 18 Lines 23-39). Further note Column 16, Lines 18-36 for

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storing an electronic book and only allowing a portion of the document to be displayed based on parental control information.

The Examiner further notes that the claims are broad and still do not convey that the restricted version of the electronic book is the entire unrestricted version of the electronic with data identifying the restricted portions. The claims only recite that the restricted version "maintains the original format of the electronic book", therefore even if Handelman taught stored an unrestricted version in a complete format and a restricted version in a redacted format (**which as taught above, Handelman does not**) this would still read on the claims because by storing a restricted version with some portions of the original unrestricted version, the restricted version would still contain/maintain some of the original format of the electronic book.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/23/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Election/Restrictions

The application contains claims 18-22 and 42-46 drawn to a nonelected invention, wherein the Restriction Requirement has been made FINAL. A complete

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reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 6-10, 25-26 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al. (U.S. Patent 6,298,441) in view of Duga et al. (U.S. Patent No. 6,195,667) in view of Moody et al. (U.S. Patent No. 5,890,177) in further view of Yoshioka et al. (U.S. Patent No. 5,553,216).

Referring to claim 1, Handelman discloses restricting access to electronic books displayed on a viewer (**see Figure 12 and Column 7, Line 66 through Column 8, Line 11**).

Handelman also discloses displaying an identification of an electronic book on a viewer (**see screen 425 in Figure 12 and Column 2, Lines 40-44 and Column 16, Lines 45-56 and Column 17, Lines 16-31**).

Handelman also discloses receiving identification information from a user (**see Column 15, Lines 41-47 for sending an identification of the user that has purchased the document**).

Handelman also discloses determining at the viewer if the user is authorized to restrict access to the electronic books (**see Column 17, Lines 27-39 and Column 18, Lines 13-40 for determining if a viewer if authorized (*based on conditional access/parental control data*) to restrict access to an electronic book document by showing redacted versions of the original document).**

Handelman also discloses that if the user is authorized, displaying the electronic book to the viewer (**see Column 17, Lines 16-19 for displaying an authorized document).**

Handelman also discloses saving an unrestricted version of the electronic book, in at least one of the library unit and the viewer (**see Column 17, Lines 3-6 and Column 18, Lines 12-22 for receiving and storing the documents in a library unit and Column 17, Lines 32-36 for receiving restricted and unrestricted versions of the document**), the unrestricted version including the original format of the electronic book (**see Column 17, Lines 27-39 and Column 18, Lines 24-39).**

Handelman also discloses creating a restricted version and saving the restricted version of the electronic book in at least one of the library unit and the viewer (**see Column 17, Lines 3-6 and Column 18, Lines 12-22 for receiving and storing the documents in a library unit and Column 17, Lines 32-36 for receiving restricted and unrestricted versions of the document and further note that if a document is received at some point prior to reception, the document(s) were created**), the restricted version including content from the original format of the electronic book and having portions of the original content deleted, (**see Column 17, Lines 27-39 and**

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Column 18, Lines 24-39 and specifically note Column 17, Lines 30-31 for the documents containing all or a portion of a document) wherein the restricted version maintains the original format of the electronic book (**see Column 17, Lines 27-36 and Column 18 Lines 23-39**).

Although Handelman teaches receiving the electronic book data at a library unit (**see Column 6, Lines 33-44**), Handelman fails to teach receiving and updating directory data of the electronic books in a library unit.

Duga discloses receiving and updating directory data of the electronic books in a library unit (**see Column 1, Lines 50-65**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Handelman, using the electronic book menu updating method, as taught by Duga, for automatically updating a menu after an electronic book is downloaded to a device, as opposed to a user having to manually enter the title of the electronic book every time the user downloads the electronic book to his/her device.

Although Handelman teaches saving a restricted and unrestricted version of the electronic book, Handelman and Duga fail to disclose receiving at the viewer an identification of restricted content from the user and that the deletions based on the identification of restricted content from the user.

Moody discloses receiving at a viewer/computer an identification of restricted content from the user and that deletions from a document are based on the

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identification of restricted content from the user (**see Column 2, Lines 30-46, Column 4, Lines 32-48, Column 5, Lines 17-22, Column 6, Lines 4-32 and Figures 1-3**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Handelman and Duga, using the document editing software, as taught by Moody, for providing editing software which makes efficient use of editor's time, yet allows rapid consolidation of the edits into a single final document (**see Column 2, Lines 20-24 of Moody**).

Handelman, Duga and Moody fail to disclose inserting a cross-reference to the restricted version of the electronic book in a header portion of the unrestricted version of the electronic book.

Yoshioka discloses inserting a cross-reference to the restricted version of the electronic book in a header portion of the unrestricted version of the electronic book (**see Figure 3 and Column 5, Lines 11-30 for an unrestricted document 3B containing a cross-reference to document structure/restricted version 3A in the header/top portion of unrestricted document 3B**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Handelman, Duga and Moody, using the document cross-referencing feature, as taught by Yoshioka, for performing document retrieval at high speeds (**see Column 3, Lines 40-41 of Yoshioka**).

Referring to claim 2, Handelman discloses receiving information on whether the electronic book contains a restriction based on an associated access level (**see Column 17, Lines 27-35 for receiving a restriction when a smart card is plugged into the document utilization module 415**).

Handelman discloses restricting access to the electronic book based upon the information (**see Column 17, Lines 27-35 for displaying only a portion of a document when the restriction is determined**) , wherein the restricting step includes restricting the access based upon a rating assigned to the electronic book (**see Column 15, Lines 49-50 for the authorization information containing ratings information used in determining if the user will be restricted access to the electronic book**), wherein the rating can be assigned to the electronic book by a user (**see Column 15, Lines 47-50**).

Further note that Dang teaches storing restrictions 417 in the header of a media file 418 that indicate which portions of information that make-up the media file (**see Figure 4**).

Referring to claim 6, see the rejection of claim 1.

Referring to claim 7, Handelman discloses permitting viewing of only selected pages of the electronic book (**the examiner notes that an electronic book inherently contains multiple pages, therefore if an entire version of an electronic book or a portion thereof is not permitted access at the viewer (see the rejection of claim 4**

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above), then the system inherently only permits viewing of selected pages of the electronic book).

Referring to claim 8, Handelman discloses permitting viewing of no portion of the electronic book **(see Column 16, Lines 18-31 for only accessing the electronic book is authorized, therefore if the user is not authorized, he/she will view no portion of the electronic book).**

Referring to claim 9, Handelman discloses permitting unlimited access to the electronic book **(see Column 16, Lines 33-36 for storing the document/electronic book on the smart cards memory 395 and Column 16, Line 64 through Column 17, Line 19 for accessing the electronic book from the smart card's memory using the authentication data, therefore, a user can access the electronic book an unlimited amount of times based on if the user is authenticated to access the electronic book stored in the smart card's memory 395).**

Referring to claim 10, see the rejection of claims 1 and 4 and further note that Handelman also discloses receiving information relating to access to the electronic book by potential users **(see Column 15, Lines 33-50 for the CA document loading unit 350 receiving requests for electronic books)** and further relating to content of the electronic book **(see Column 15, Lines 43-50 for the request information including various types of content related information of the electronic book).** Further note

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that the restricted is a separate version and therefore contains content deleted without changing the original format of the unrestricted version.

Referring to claims 25-26, see the rejection of claims 1-3 and 10.

Referring to claim 30, see the rejection of claim 1.

Referring to claims 31-33, see the rejection of claims 7-9, respectively.

Referring to claim 34, see the rejection of claim 10.

Claim 3 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman et al. (U.S. Patent 6,298,441) in view of Duga et al. (U.S. Patent No. 6,195,667) in view of Moody et al. (U.S. Patent No. 5,890,177) in further view of Yoshioka et al. (U.S. Patent No. 5,553,216) in further view of Block et al. (U.S. Patent No. 6,675,384).

Referring to claim 3, Handelman, Duga, Moody and Yoshioka disclose all of the limitations in claim 1, as well as Handelman teaching that the restricting step includes permitting viewing of text within the electronic book (**see Column 2, Lines 39-43**), but fails to teach permitting no viewing of images within the electronic book.

Block discloses creating an image mask to block an image from being displayed (**see Figure 11 and Column 18, Lines 55 through Column 19, Line 17**). Further note that Block clearly teaches that the system can be implemented in an electronic book system (**see Column 2, Lines 50-56**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book viewer, as taught by the combination of Handelman, Duga, Moody and Yoshioka, using the masking technology, as taught by Block, for the purpose of providing a substitute program signal instead of the offensive or undesirable portions of a program/book (**see Column 2, Lines 19-22 and 50-56 of Block**).

Referring to claim 27, see the rejection of claim 3.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman et al. (U.S. Patent No. 5,761,681) in view of Duga et al. (U.S. Patent No. 6,195,667) in further view of Handelman et al. (U.S. Patent 6,298,441) in view of Moody et al. (U.S. Patent No. 5,890,177) in further view of Yoshioka et al. (U.S. Patent No. 5,553,216).

Referring to claim 50, Huffman discloses electronically displaying a page of an electronic book on a viewer (**see Figure 5**) and permitting a user to restrict content of the electronic book (**see Figure 37**).

Huffman also discloses displaying a screen on a viewer (**see Figure 5 for displaying a screen on the electronic book viewer**).

Huffman also discloses displaying within the screen a page of an electronic book (**see step 450 in Figure 38 for displaying a current page of the electronic book**), the page including at least a portion of content of the electronic book (**see Column 17,**

Lines 56-59 for displaying a page which includes a portion of the electronic book).

Huffman also discloses permitting a user to identify at least a portion of the content displayed within the screen (**see step 454 in Figure 38 which allows a user to select a portion of the text in the currently displayed page of the electronic book (also note Column 24, Lines 1-2).**).

Huffman discloses displaying a section within the screen for permitting the user to request restriction of the identified content (**see Column 24, Lines 2-13 for requesting a substitute name in a dialog box display section**). The examiner notes that by replacing a name with a new name, restriction to the name is accomplished.

Although Huffman discloses receiving and storing the electronic book in a library unit (**see Column 6, Lines 3-8**), Huffman fails to disclose indexing the electronic book within an index of the library unit and displaying a screen with the index having the electronic book.

Duga discloses storing and indexing an electronic book in a library unit (**see Column 1, Lines 50-65**) and displaying a directory having the stored electronic book on a viewer (**see Column 1, Lines 61-63**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Huffman, using the electronic book menu updating method, as taught by Duga, for automatically updating a menu after an electronic book is downloaded to a device, as opposed to a

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user having to manually enter the title of the electronic book every time the user downloads the electronic book to his/her device.

Handelman discloses restricting access to electronic books displayed on a viewer (**see Figure 12 and Column 7, Line 66 through Column 8, Line 11**).

Handelman also discloses displaying an identification of an electronic book on a viewer (**see screen 425 in Figure 12 and Column 2, Lines 40-44 and Column 16, Lines 45-56 and Column 17, Lines 16-31**).

Handelman also discloses receiving identification information from a user (**see Column 15, Lines 41-47 for sending an identification of the user that has purchased the document**).

Handelman also discloses determining at the viewer if the user is authorized to restrict access to the electronic books (**see Column 17, Lines 27-39 and Column 18, Lines 13-40 for determining if a viewer if authorized (*based on conditional access/parental control data*) to restrict access to an electronic book document by showing redacted versions of the original document**).

Handelman also discloses that if the user is authorized, displaying the electronic book to the viewer (**see Column 17, Lines 16-19 for displaying an authorized document**).

Handelman also discloses saving an unrestricted version of the electronic book, the unrestricted version including the original format of the electronic book (**see Column 17, Lines 27-39 and Column 18, Lines 24-39**).

Handelman also discloses saving a restricted version of the electronic book, the restricted version including content from the original format of the electronic book but having the restricted content deleted, wherein the restricted version maintains the original format of the electronic book (**see Column 17, Lines 27-39 and Column 18, Lines 24-39**).

Although Handelman teaches saving a restricted and unrestricted version of the electronic book, Huffman, Duga and Handelman fail to disclose receiving at the viewer an identification of restricted content from the user and that the deletions based on the identification of restricted content from the user.

Moody discloses receiving at a viewer/computer an identification of restricted content from the user and that deletions from a document are based on the identification of restricted content from the user (**see Column 2, Lines 30-46, Column 4, Lines 32-48, Column 5, Lines 17-22, Column 6, Lines 4-32 and Figures 1-3**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Handelman and Duga, using the document editing software, as taught by Moody, for providing editing software which makes efficient use of editor's time, yet allows rapid consolidation of the edits into a single final document (**see Column 2, Lines 20-24 of Moody**).

Huffman, Duga, Handelman and Moody fail to disclose inserting a cross-reference to the unrestricted version of the electronic book in a header portion of the restricted version of the electronic book.

Yoshioka discloses inserting a cross-reference to the restricted version of the electronic book in a header portion of the unrestricted version of the electronic book (see **Figure 3 and Column 5, Lines 11-30 for an unrestricted document 3B containing a cross-reference to document structure/restricted version 3A in the header/top portion of unrestricted document 3B**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the electronic book system, as taught by Huffman, Duga, Handelsman and Moody, using the document cross-referencing feature, as taught by Yoshioka, for performing document retrieval at high speeds (**see Column 3, Lines 40-41 of Yoshioka**).

Allowable Subject Matter

Claims 12-17 and 36-41 are allowed.

The Examiner's reasons for allowance will be provided once a notice of allowance is issued for the instant application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2421

Jason P Salce
Primary Examiner
Art Unit 2421

June 29, 2009